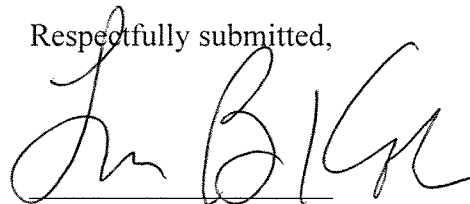


REMARKS

Claims 81, which is allowed, is currently pending.

Claim 82 is cancelled without prejudice to the prosecution of its subject matter in other patent applications, in order to put this application in order for allowance. However, Applicants maintain that the Examiner's position, that claim 82 does not satisfy the written description requirement of 35 U.S.C. §112 because it covers nucleic acid molecules that hybridize to the coding region of the mda-7 gene under stringent conditions, is not correct. In that regard, Applicants invite the Examiner's attention to pages 35-37 of the "SYNOPSIS OF APPLICATION OF WRITTEN DESCRIPTION GUIDELINES," (a copy of which is attached hereto as Exhibit A) which provides an example similar to the instant case where written description was found to be sufficient. By not allowing claim 82, the Examiner provides potential infringers with the opportunity to make insignificant variations of the MDA-7 protein sequence to escape the scope of claim 81. Applicants do not wish their position to be prejudiced by the cancellation of claim 82, which is done now to secure issuance of a case which has been pending for almost six years, so that the subject matter of claim 82 may be pursued in a continuation application. Because only claim 81 is now pending, and that claim is allowed, the application is believed to be in order for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Lisa B. Kole', is written over a horizontal line.

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EXHIBIT A

e.g. expression vectors, the necessary common attribute is the ORF (SEQ ID NO: 2).

Weighing all factors including (1) that the full length ORF (SEQ ID NO: 2) is disclosed and (2) that any substantial variability within the genus arises due to addition of elements that are not part of the inventor's particular contribution, taken in view of the level of knowledge and skill in the art, one skilled in the art would recognize from the disclosure that the applicant was in possession of the genus of DNAs that comprise SEQ ID NO: 2.

Conclusion: The written description requirement is satisfied.

Example 9: Hybridization

Specification: The specification discloses a single cDNA (SEQ ID NO:1) which encodes a protein that binds to a dopamine receptor and stimulates adenylate cyclase activity. The specification includes an example wherein the complement of SEQ ID NO: 1 was used under highly stringent hybridization conditions (6XSSC and 65 degrees Celsius) for the isolation of nucleic acids that encode proteins that bind to dopamine receptor and stimulate adenylate cyclase activity. The hybridizing nucleic acids were not sequenced. They were expressed and several were shown to encode proteins that bind to a dopamine receptor and stimulate adenylate cyclase activity. These sequences may or may not be the same as SEQ ID NO: 1.

Claim:

An isolated nucleic acid that specifically hybridizes under highly stringent conditions to the complement of the sequence set forth in SEQ ID NO: 1,

wherein said nucleic acid encodes a protein that binds to a dopamine receptor and stimulates adenylate cyclase activity.

Analysis:

A review of the full content of the specification indicates that the essential feature of the claimed invention is the isolated nucleic acid that hybridizes to SEQ ID NO: 1 under highly stringent conditions and encodes a protein with a specific function. The art indicates that hybridization techniques using a known DNA as a probe under highly stringent conditions were conventional in the art at the time of filing.

The claim is drawn to a genus of nucleic acids all of which must hybridize with SEQ ID NO: 1 and must encode a protein with a specific activity.

The search of the prior art indicates that SEQ ID NO: 1 is novel and unobvious.

There is a single species disclosed (a molecule consisting of SEQ ID NO: 1) that is within the scope of the claimed genus.

There is actual reduction to practice of the disclosed species.

Now turning to the genus analysis, a person of skill in the art would not expect substantial variation among species encompassed within the scope of the claims because the highly stringent hybridization conditions set forth in the claim yield structurally similar DNAs. Thus, a representative number of species is disclosed, since highly stringent hybridization conditions in combination with the coding function of DNA and the level of

skill and knowledge in the art are adequate to determine that applicant was in possession of the claimed invention.

Conclusion: The claimed invention is adequately described.